

placing a coupon on a container with coupon applying means, not in a container.

Applicant's invention in claims 5, 8, 10 and 12 is directed to inserting a coupon into a container, not merely placing a coupon on a container as in Lewis.

With respect to claims 6 and 8, Roetter and Lewis, alone or in combination, do not address the problem solved by Applicant's invention. Neither Roetter nor Lewis address when to insert a coupon into a container. Both Roetter and Lewis cut or burst at regular intervals. Roetter teaches the use of a signal to recognize that the next paper is properly advanced and ready to be bursted. There is no concern for the paper after it is burst. Lewis does not have any form of timing signal and relies on regularity in spacing between containers and cutting coupons at regular intervals to reliably and positively place one coupon onto each container. Under this approach, the mechanism would attempt to place the coupon on the package regardless of whether a package was present to receive the coupon. Applicant's invention is directed at addressing this inefficiency by linking a signal to when a package or container is present or will be present to receive the coupon. In this manner, as described in Applicant's specification, the present invention can be used to positively insert one coupon in each container even if each container is moving at a different speed or the containers are spaced at inconsistent intervals.

Accordingly, Applicant believes that the Examiner's §103(a) objections to claims 5-12 should be withdrawn.

### **CONCLUSION**

For the aforementioned reasons, Applicant respectfully submits that the Examiner's rejections under the judicially created doctrine of obviousness-type double patenting and 35 U.S.C. §103(a) are not well taken and should be withdrawn. Applicant

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987). The Board of Patent Appeals and Interferences noted “When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper.... Absent such reasons or incentives, the teachings of the references are not combinable.” *Ex parte Skinner*, 2 USPQ2d 1788, 1790 (Bd. Pat. App. & Int’f, 1987). Applicant submits that there is no reason or incentive to combine Roetter and Lewis as there exists no suggestion to use a burster for inserting coupons into packages. There is no evidence that the Roetter burster would operate with the coupon applying means in Lewis. Roetter’s forwardmost coupon is always moving, while Lewis’ is stationary for cutting and application on a package.

Moreover, Roetter and Lewis are nonanalogous art. There is no showing that a person of ordinary skill, seeking to solve the problem of reliably inserting coupons into packages, would be reasonably expected or motivated to look to methods for bursting computer printer paper. The combination of elements from non-analogous sources, in a manner that reconstructs the Applicant’s invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992).

With respect to claims 5, 8, 10, and 12, Roetter and Lewis do not, alone or in combination, address the problem solved by Applicant’s invention. Roetter is not concerned with inserting anything into a container. Indeed Roetter gives no thought as to what happens to the paper after it is burst from the apparatus. Lewis is concerned with

Kotsiopoulos, U.S. Patent No. 5,079,901, in view of Kuehl et al., U.S. Patent No. 5,966,906 (hereinafter Kuehl). Applicant respectfully disagrees with this assessment.

Applicant's present application is the latest in a series of proper continuations from Serial No. 07/348,860 filed on May 8, 1989. Applicant accordingly submits that the present application is entitled to and claims a priority date of May 8, 1989. This application predates the Kuehl reference cited by the Examiner, which has a filing date of Sept. 17, 1998 and an issue date of October 19, 1999. Because Applicant's present application predates Kuehl, the Examiner was incorrect in using Kuehl as a reference for obviousness-type double patenting. Accordingly, Applicant respectfully requests that the Examiner's objection under the judicially created doctrine of obviousness-type double patenting to claims 2-4 be withdrawn.


## **2) Claim Rejections under §103(a)**

In this Office Action the Examiner rejected claims 5-12 under 35 U.S.C. §103(a) as being unpatentable over Roetter et al., U.S. Patent No. 4,261,497 (hereinafter Roetter) in view of Lewis et al., U.S. Patent No. 4,468,912 (hereinafter Lewis). Applicant submits that Roetter and Lewis do not teach the Applicant's invention alone or in combination with other prior art and gives no suggestion to combine or modify the references.

The combination of Roetter and Lewis would not have been obvious to one of ordinary skill in the art. Roetter teaches a bursting means directed towards the separation of computer printer paper, while Lewis teaches a cutting knife means for separating coupons. There is no suggestion or motivation for one of ordinary skill in the art to attempt to combine these two patents espousing contradictory means of separating individual items from a continuous whole.

further submits that claims 2-12 are in condition for allowance and respectfully requests the same.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "S. Trybus", is written over a horizontal line.

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